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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,043	05/11/2001	Dwayne Yount	40204	5072

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EXAMINER

SOHN, SEUNG C

ART UNIT PAPER NUMBER

2878

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/853,043	YOUNT ET AL.
	Examiner Seung C. Sohn	Art Unit 2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-7,11-20,22-24 and 28-53 is/are pending in the application.
 - 4a) Of the above claim(s) 11-17 and 28-34 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-7,18-20,22-24 and 35-53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 May 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arithmetic device in claims 1, 5, 40, 41 and the comparator in claim 44 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
 - On page 13, lines 9 and 22, "Fig. 3" should be changed to -- Fig. 7 --.
 - On page 13, lines 17 and 19, "further assembly" should be changed to – filter assembly --.Appropriate correction is required.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Specification does not provide a reason why the arithmetic device is a distinguished feature of the invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. ***Claims 1-3, 5-7, 18-20, 22-24, 40-43 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over van den Engh et al. (Patent No. US 5,150,313) in view of Bierhoff (Patent No. US 4,813,031).***

Referring to claims 1 and 40, Engh et al. shows in Fig. 5A the following elements of Applicant's claim:

- a) a detector (20a), adapted to detect light emitted from said event in said flow cytometer and to generate a signal representative of said emitted light (Col. 8, lines 4-7); and
- b) a sampling device (23a, i.e., A/D converter), adapted to receive portions of said signal from said detector (20a) in time sequence (by 25, i.e., Central Timing Unit) and to generate a respective value representative of the respective magnitude of each respective portion of said signal as said respective portion of said signal is being received (Col. 8, lines 8-49).

Engh et al. does not disclose an arithmetic device, adapted to arithmetically combine a designated value with each of said values. Bierhoff discloses an arithmetic device (37, i.e., processing circuit), adapted to arithmetically combine a designated value (a bar) with each of said values (Col. 5, lines 13-15). It would have been obvious

to one of ordinary skill in the art to provide an arithmetic device of Bierhoff in the device of Engh et al. for the purpose of improving the generation of the control signals (Col. 1, lines 42-43).

Referring to claim 2, Engh et al. discloses that said sampling device (23a) receives a number of said portions totaling substantially all of said signal, and generates said values which represent said portions of substantially all of said signal (Col. 1, lines 47-51).

Referring to claim 3, Engh et al. discloses that said signal is an analog signal representative of a light signal emitted from said event as detected by said detector (20a) (Col. 8, lines 4-14).

Referring to claims 5 and 41, Bierhoff shows in Fig. 4 that said arithmetic device (37) includes a subtractor (69 & 70) which is adapted to subtract said designated value from each of said values (Col. 6, lines 49-51).

Referring to claims 6 and 42, Bierhoff discloses that said designated value (a bar) is representative of an undesired signal detected by said detector (11a) (Col. 5, lines 1-8).

Referring to claims 7 and 43, Bierhoff discloses that said designated value (a bar) is representative of a characteristic of said detector (11a) (Col. 5, lines 9-12).

Referring to claims 18 and 50, Engh et al. discloses the following steps of Applicant's claim:

- a) generating a signal representative of light emitted from said event in said flow cytometer using a detector (20a) (Col. 8, lines 4-7);

b) receiving portions of said signal from said detector (20a) in time sequence (Col. 8, lines 4-7); and

c) generating a respective value representative of the respective magnitude of each respective portion of said signal as said respective portion of said signal is being received (Col. 8, lines 8-49).

Engh et al. does not disclose a step of arithmetically combining a designated value with each of said values. Bierhoff discloses a step of arithmetically combining a designated value (a bar) with each of said values (Col. 5, lines 13-15). It would have been obvious to one of ordinary skill in the art to provide an arithmetically combining step of Bierhoff in the method of Engh et al. for the purpose of improving the generation of the control signals (Col. 1, lines 42-43).

Referring to claim 19, Engh et al. discloses that said receiving receives a number of said portions totaling substantially all of said signal (Col. 1, lines 47-51).

Referring to claim 20, Engh et al. discloses that said signal is an analog signal representative of a light signal emitted from said event as detected by said detector (20a) (Col. 8, lines 4-14).

Referring to claims 22 and 51, Bierhoff discloses that said arithmetic combining includes subtracting said designated value from each of said values (Col. 6, lines 49-51).

Referring to claims 23 and 52, Bierhoff discloses that said designated value (a bar) is representative of an undesired signal detected by said detector (Col. 5, lines 1-8).

R ~~f~~ **rring to claim 24**, Bierhoff discloses that said designated value is representative of a characteristic of said detector (Col. 5, lines 9-12).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. ***Claims 35-39, 44, 45-49 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by van den Engh et al. (Patent No US 5,150,313).***

Referring to claim 35, Engh et al. shows in Fig. 5A the following elements of Applicant's claim:

- a) a first detector (20a) and a second detector (20b), each adapted to detect light emitted from event in said flow cytometer and to generate a signal representative of said emitted light (Col. 8, lines 4-7);
- b) a sampling device(23a, 23b), adapted to receive portions of a first signal from said first detector in time sequence and to generate a respective value representative of the respective magnitude of each respective portion of said first signal as said respective portion of said first signal is being received, and to receive portions of a second signal from said second detector in time sequence and to generate a respective value representative of the respective magnitude of each respective portion of said second signal as said respective

portion of said second signal is being received, wherein said sampling device receives said portions of said first signal at a time different from that during which said sampling device receives at least some of said portions of said second signal (Col. 8, lines 8-49); and

c) a storage device (24a, 24b), adapted to receive said values generated by said sampling device and to impose a delay on said values from at least one of said first and second signals (Col. 8, lines 4-49).

Referring to claim 36, Engh et al. discloses that said storage device (24a, 24b) time correlates said values generated from said first signal with said values generated from said second signal (Col. 12, lines 50-66).

Referring to claim 37, Engh et al. discloses that said delay corresponds to a distance between interrogation points of said respective first and second detectors (Col. 1, lines 36-68).

Referring to claim 38, Engh et al. discloses that said sampling device (23a) receives a number of said portions totaling substantially all of said signals, and generates said values which represent said portions of substantially all of said signals (Col. 1, lines 47-51).

Referring to claim 39, Engh et al. discloses that each of said signals is an analog signal representative of a light signal emitted from said event as detected by said detector (20a) (Col. 8, lines 4-14).

Referring to claim 44, Engh et al. discloses that a comparator (37), adapted to compare each of said values generated from said first signal with a respective one of said values generated from said second signal (Col. 9, lines 12-39).

Referring to claim 45, Engh et al. discloses the following steps of Applicant's claim:

- a) generating a first signal and a second signal representative of light emitted from said event in said flow cytometer detected using a first detector and a second detector, respectively (Col. 8, lines 4-7);
- b) receiving portions of said first signal and said second signal in time sequence, wherein said portions of said first signal are received at a time different from that during which at least some of said portions of said second signal are received;
- c) generating a respective value representative of the respective magnitude of each respective portion of said first signal as said respective portion of said first signal is being received;
- d) generating a respective value representative of the respective magnitude of each respective portion of said second signal as said respective portion of said second signal is being received (Col. 8, lines 8-49); and
- e) storing said values generated from said first and second signals and imposing a delay on said values from at least one of said first and second signals (Col. 8, lines 4-49).

Referring to claim 46, Engh et al. discloses that the step of time correlating said values generated from said first signal with said values generated from said second signal (Col. 12, lines 50-66).

Referring to claim 47, Engh et al. discloses that said delay corresponds to a distance between interrogation points of said respective first and second detectors (Col. 1, lines 36-68).

Referring to claim 48, Engh et al. discloses that said receiving receives a number of said portions totaling substantially all of said signal (Col. 1, lines 47-51).

Referring to claim 49, Engh et al. discloses that each said signal is an analog signal representative of a light signal emitted from said event as detected by one of said detectors (20a) (Col. 8, lines 4-14).

Referring to claim 53, Engh et al. discloses that comparing each of said values generated from said first signal with a respective one of said values generated from said second signal (Col. 9, lines 12-39).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Groner et al. (Patent No. US 6,221,671) discloses a digital flow cytometer.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung C. Sohn whose telephone number is (703) 308-4093. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (703) 308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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SCS
July 23, 2003



KEVIN PYO
PRIMARY EXAMINER